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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|---|-------------|----------------------|----------------------------|------------------------|
| 10/607,585  | 06/26/2003  | Timothy Alan Dietz   | AUS920030172US1            | 5966                   |
| 25299 7590 02/06/2008<br>IBM CORPORATION<br>PO BOX 12195<br>DEPT YXSA, BLDG 002<br>RESEARCH TRIANGLE PARK, NC 27709 |             |                      | EXAMINER<br>NGUYEN, DUSTIN |                        |
|   |             |                      | ART UNIT<br>2154           | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>02/06/2008    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/607,585

Applicant(s)

DIETZ ET AL.

Examiner

Dustin Nguyen

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6,8,13,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,8,13,21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1, 6, 8, 13, 21 and 23 are presented for examination.

### *Response to Arguments*

2. Applicant's arguments filed 12/25/2007 have been fully considered but they are not persuasive.
3. As per remarks, Applicants traversed the rejection of claim 21 under 35 U.S.C. 101. Claim 21 claims for "a computer program comprising a computer useable medium having a computer readable program". Applicant's disclosure contains no explicit and deliberate definition for the term "computer useable medium", and in the context of the disclosure and claims in question, one of ordinary skill would reasonably interpret "a computer program comprising the computer useable medium having a computer readable program" as a software application. As such, the system of software alone is not a machine, and it is clearly not a process, manufacture nor composition of matter. Therefore, the claim remains rejected under 35 U.S.C. 101.
4. As per remarks, Applicants' argued that (1) Anderson fails to teach "apparatus in said service provider to convert the original URLs of said accessed Web documents to include a domain section specifying the service provider's domain", specifically Applicants' argued that in

Anderson, the conversion from primary (original) to secondary is not done in the service provider.

5. As to point (1), in Figure 2, Anderson discloses the process of mapping of a secondary address to a primary address. The process includes the step of checking to see whether or not the specified numeric suffix is one for which the mapping to the primary address is already held within a local cache within the mobile telephone [ 22, Figure 2; and paragraph 0054 ].

Applicants' remark correctly identifies that Anderson reference teaches the conversion to the primary address at the user terminal if the local caches does contain the primary address [ 24, 26, Figure 2; and paragraph 0055 ], and also the Anderson reference also teaches the conversion to the primary address at the service provider if the local caches does not contain the primary address by sending the secondary address from the user terminal to the bango server and the banger server maps secondary address to primary address [ i.e. broadly interpreted as apparatus in said service provider to convert the original URLs of said accessed Web documents as claimed ] [ 30-38, Figure 2; and paragraph 0056 ].

6. As per remarks, Applicants' argued that (2) Anderson does not disclose "user activating said step of converting is a host of a Web database source defining the original URL".

7. As to point (2), it is rejected for same reasons as stated in previous Office Action. Furthermore, Anderson discloses the above limitation [ i.e. a user wishing to register a particular

numeric suffix enters that into a web page hosted by the remote database server ] [ paragraphs 0061, 0081 and 0108 ].

### *Specification*

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “a computer useable medium” is lack of antecedent basis.

### *Claim Rejections - 35 USC § 101*

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-23 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claim 21, “a compute program comprising a computer useable medium having a computer readable program” is being considered as non-statutory subject matter [ i.e. software per se ], fails to fall within a statutory category of invention, it is not a machine, and it is clearly not a process, manufacturer nor composition of matter [ Please see MPEP Chapter 2106 ].

### *Claim Rejections - 35 USC § 112*

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

I. the original URLs - claim 1

*Claim Rejections - 35 USC § 102*

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 6, 8, 13, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. [ US Patent Application No 2003/0182449 ].

14. As per claim 1, Anderson discloses the invention as claimed including in a World Wide Web (Web) communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received Web documents accessible from database sources on the Web [ Figure 1; and paragraphs 0046-0049 ], a system for simplifying the Uniform Resource Locators (URLs) displayed for each received Web document [ simplify a particular web site ] [ Figure 3; and paragraph 0058 ] comprising:

service provider for accessing Web documents for said receiving display stations responsive to user requests [ i.e. ISPs or Web page providers ] [ paragraphs 0050 and 0053 ];

remote Web database source servers [ 8, Figure 1; and paragraph 0049 ], responsive to service provider requests including:

apparatus for accessing requested Web documents from said a database sources [ i.e. the web site server responds to the request ] [ 6, Figure 1; and paragraph 0049 ], and

apparatus for defining the URLs for said accessed Web documents to include a URL domain section and automatically generated URL path portion within the database source [ i.e. i.e. map secondary address to primary address ] [ 32, Figure 2; Figure 3; and paragraphs 0056-0059 ]; and

apparatus in said service provider to convert the original URLs of said accessed Web documents to include a domain section specifying the service provider's domain and a path portion within said service provider's domain simpler and shorter than the original URL path portion [ i.e. secondary address is shorter than primary address ] [ Figure 3; Abstract; and paragraphs 0013, 0048, 0049 and 0103-0105 ];

apparatus in said service provider for respectively reconvert ing said converted URLs back to the original URLs; wherein Web document requests directed to said converted URLs will respectively be transmitted through the service provider to remote database sources on the Web [ i.e. lookup mapping to determine primary address ] [ Figure 3; paragraphs 0013, 0049, 0056 and 0062 ]; and

apparatus in said service provider for charging a user a fee for activating said apparatus for converting an original URL [ paragraphs 0109-0120 ].

15. As per claim 6, Anderson discloses wherein said user activating said apparatus for converting is a host of a Web database source defining the original URL [ Figure 1; and paragraphs 0049 and 0085 ].

16. As per claims 8 and 13, they are rejected for similar reasons as stated above in claims 1 and 6.

17. As per claims 21 and 23, they are rejected for similar reasons as stated above in claims 1 and 6.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

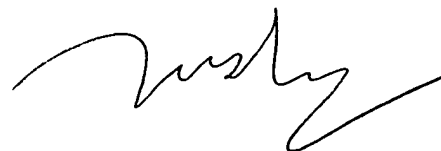
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Dustin Nguyen

Examiner

Art Unit 2154

A handwritten signature in black ink, appearing to read 'Dustin Nguyen', written over the printed name and title.